

## Sellers, Robert

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**From:** Tierney, Christine  
**Sent:** Tuesday, July 24, 2007 9:29 AM  
**To:** Sellers, Robert  
**Cc:** Dunn, Tom  
**Subject:** RE: Question re 102(a) "by others" in 10/632,284

I agree. I believe that enough evidence has been provided to overcome the rejection (specifically the dec by the inventors of the patent application saying that the subject matter of the article is their own work).

-----Original Message-----

**From:** Dunn, Tom  
**Sent:** Monday, July 23, 2007 5:36 PM  
**To:** Sellers, Robert; Tierney, Christine  
**Subject:** RE: Question re 102(a) "by others" in 10/632,284

If the declaration looks to be in order (other than the deceased inventor) then you should withdraw the rejection. We generally do not require for every named person on the article to come in and make an affidavit. If it turns out later on that Smalley was involved in the claimed subject matter, and it gets into court, then any fraudulent activity would come back to bate them.

-----Original Message-----

**From:** Sellers, Robert  
**Sent:** Monday, July 23, 2007 1:35 PM  
**To:** Tierney, Christine; Dunn, Tom  
**Subject:** FW: Question re 102(a) "by others" in 10/632,284

Since Bill Krynski is out until July 30th, his Auto Reply suggested your help.

-----Original Message-----

**From:** Sellers, Robert  
**Sent:** Monday, July 23, 2007 1:32 PM  
**To:** Krynski, William  
**Subject:** Question re 102(a) "by others" in 10/632,284

A 35 U.S.C. 102(a) rejection was applied (1/17/2007) in application no. **10/632,284** over an article authored by Bahr, Yang, Kosynkin, Bronikowski, **Smalley** and Tour. The application inventors are Bahr, Yang and Tour.

132 affidavits have been filed by Bahr, Yang and Tour acknowledging that the subject matter of the article is their own work. Kosynkin and Bronikowski in their 132 affidavits admit that the article is the inventive entity's work. Accordingly, Kosynkin and Bronikowski are not the authors of the portion of the article relied upon in the 35 U.S.C. 102(a) rejection.

The problem is that Smalley, the other author of the article, is deceased. There is no discussion of this circumstance in MPEP 2132.01 in the section entitled "Applicant Can Rebut *Prima Facie* Case by Showing Reference's Disclosure was Derived from Applicant's Own Work."

Should the 35 U.S.C. 102(a) rejection be maintained? What is the remedy for applicants' regarding the deceased inventor's involvement with the article?

Your opinion is respectfully solicited.